

JCO3 Rec'd PCT/PTO 23 JUL 2001 #3

Docket No. : **MR-25PCT**  
U.S. Application No. : **09/831,996**  
International Application No. : **PCT/EP99/08602**  
International Filing Date. : **NOVEMBER 10, 1999**  
Priority Dates Claimed : **NOVEMBER 17, 1998 and MARCH 5, 1999**  
Title of Invention : **NAVIGATION SYSTEM FOR PERFORMING AND ASSISTING SURGICAL  
OPERATIONS, MARKING DEVICE OR FIDUCIAL, AND POINTER FOR  
A TRACKING DEVICE IN A NAVIGATION SYSTEM**  
Applicant(s) for (DO/EO/US) : **Thomas Hoell, Udo Warschewske and Hans-Martin von Stockhausen**

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. \_\_\_ This is a FIRST submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. 371.
3. \_\_\_ This express request to begin national examination procedures 35 U.S.C. 371 (f) at any time rather than delay examination until the expiration of the applicable time limit set forth in 35 U.S.C 371(b) and PCT Articles 22 and 39(1).
4. \_\_\_ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. \_\_\_ A copy of the International Application as filed [35 U.S.C. 371(c)(2)].
  - a) \_\_\_ is transmitted herewith (required only if not transmitted by the International Bureau).
  - b) \_\_\_ has been transmitted by the international Bureau.
  - c) \_\_\_ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. \_\_\_ A translation of the International Application into English [35 U.S.C.371(c)(2)].
7. \_\_\_ Amendments to the claims of the International Application under PCT Article 19 [35 U.S.C.371(c)(3)].
  - a) \_\_\_ are transmitted herewith (required only if not transmitted by the International Bureau).
  - b) \_\_\_ have been transmitted by the International Bureau.
  - c) \_\_\_ have not been made; however, the time limit for making such amendments has NOT expired.
  - d) \_\_\_ have not been made and will not be made.
8. \_\_\_ A translation of the amendments to the claims under PCT Article 19 [35 U.S.C.371(c)(3)].
9. \_\_\_ An oath or declaration of the inventor(s) [35 U.S.C.371(c)(4)]. **UNSIGNED**
10. \_\_\_ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 [35 U.S.C.371(c)(5)].

Items 11. to 16. below concern other document(s) or information included:

11. \_\_\_ An Information Disclosure Statement under 37 C.F.R. 1.97 and 198.
12. \_\_\_ An Assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. \_\_\_ A FIRST preliminary amendment.  
\_\_\_ A SECOND or SUBSEQUENT preliminary amendment.
14. \_\_\_ A substitute specification.
15. \_\_\_ A change of power of attorney and/or address letter.
16. ☒ (other items or information) **INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D. C. 20231, on July 18, 2001.

By: Friedrich Kueffner Date: July 18, 2001

17. The following fees are submitted:

**BASIC NATIONAL FEE [37 CFR 1.492(a)(1)-(5)]:**

- ☐ Search Report has been prepared by the EPO or JPO..... \$ 930.00
- ☐ International preliminary examination fee paid to USPTO [37 CFR 1.482]:..... \$ 700.00
- ☐ No International preliminary examination fee paid to USPTO [37 CFR 1.482]  
but International search fee paid to USPTO [37CFR 1.445(a)(2)]:..... \$ 760.00
- ☐ Neither International preliminary examination fee [37 CFR 1.482] nor  
International search fee [37 CFR 1.445(a)(2)] paid to USPTO:..... \$ 970.00
- ☐ International preliminary examination fee paid to USPTO [37 CFR 1.482]  
and all claims satisfied provisions of PCT Article 33 (2) to (4):..... \$ 96.00

**ENTER APPROPRIATE BASIC FEE AMOUNT:** \$

Surcharge of \$ 130.00 for furnishing the oath or declaration later than 20 30 months  
from the earliest claimed priority date [37 CFR 1.492(e)]

Claims	filed	Extra	Rate
Total Claims	22	-20=	x \$ 18.=
Indep. Claims	3	- 3=	x \$ 78.=
Multiple Dependent Claims (if applicable) + \$ 260.=			

**TOTAL OF ABOVE CALCULATIONS:** \$

Reduction by  $\frac{1}{2}$  for filing by small entity, if applicable. Verified Small Entity  
Statement must be filed also. [Note 37 CFR 1.9, 1.27, 1.28]

(divided by 2)

**SUBTOTAL:** \$

Processing fee of \$ 130.00 for furnishing the English translation later than 20 30 months  
from the earliest claimed priority date [37 CFR 1.492(f)]

**TOTAL NATIONAL FEE:** \$

Fee for recording the enclosed assignment [37 CFR 1.21(h)] The assignment must be  
accompanied by an appropriate cover sheet [37 CFR 3.28, 3.31]. \$ 40.00 per property

**TOTAL FEES ENCLOSED:** \$

**AMOUNT TO BE REFUNDED:** Refunded \$

**AMOUNT TO BE CHARGED:** Charged \$

- a) ☐ A check in the amount of \$ to cover the above fees is enclosed.
- b) ☐ Please charge my Deposit Account No. 11-1835 in the amount of \$ to cover the above fees.  
A duplicate copy of this sheet is enclosed.
- c) ☐ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any  
overpayment to Deposit Account No. 11-1835. A duplicate copy of this sheet is enclosed.

NOTE: Where an appropriate time limit under 36 CFR 1.494 or 1.495 has not been met, a petition to revive [37 CFR 1.137(a) or (b)] must  
be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO: Friedrich Kueffner  
342 Madison Avenue  
Suite 1921  
New York, NY 10173

Friedrich Kueffner  
Name

  
signature

29,482  
Reg. No.

July 18, 2001  
Date

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference M/NIL-011-PC	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP99/08602	International filing date (day/month/year) 10 November 1999 (10.11.99)	Priority date (day/month/year) 17 November 1998 (17.11.98)
International Patent Classification (IPC) or national classification and IPC A61B 19/00		
Applicant NICOLET BIOMEDICAL INC.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

☒ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 5 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☒ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 23 May 2000 (23.05.00)	Date of completion of this report 16 February 2001 (16.02.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP99/08602

## I. Basis of the report

1. This report has been drawn on the basis of (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

- ☐ the international application as originally filed.
- ☒ the description, pages 1-24, as originally filed,  
pages \_\_\_\_\_, filed with the demand,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- ☒ the claims, Nos. \_\_\_\_\_, as originally filed,  
Nos. \_\_\_\_\_, as amended under Article 19,  
Nos. \_\_\_\_\_, filed with the demand,  
Nos. 1-17, filed with the letter of 22 November 2000 (22.11.2000),  
Nos. \_\_\_\_\_, filed with the letter of \_\_\_\_\_.
- ☒ the drawings, sheets/fig 1/10-10/10, as originally filed,  
sheets/fig \_\_\_\_\_, filed with the demand,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_,  
sheets/fig \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

## 2. The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

## 4. Additional observations, if necessary:

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## IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☒ not complied with for the following reasons:

See supplemental sheet.

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☐ all parts.
- ☒ the parts relating to claims Nos. 1-7

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: IV

The application lacks unity of invention within the meaning of PCT Rule 13, because independent Claims 1, 8 and 13 do not appear to contain any identical or corresponding special features within the meaning of PCT Rule 13(2) (see the characterising part of Claims 1, 8 and 13). Thus the inventions according to Claims 1, 8 and 13 are not linked so as to form a single general inventive concept. Consequently, the application appears to contain the following three groups of possible inventions:

Group 1: Claims 1-7 and 17

Group 2: Claims 8-12

Group 3: Claims 13-16.

The necessary additional search fees have not been paid in time. Therefore Claims 8-17 have not been investigated, and the examination of the claims within the meaning of PCT Article 33(2) to (4) is limited to Claims 1-7 (Claim 17 also incorporates the subject matter of Claim 13).

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## V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

### 1. Statement

Novelty (N)	Claims	1-7	YES
	Claims		NO
Inventive step (IS)	Claims	1-7	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-7	YES
	Claims		NO

### 2. Citations and explanations

WO-A-96/32059 (D1) discloses a navigation system according to the preamble to Claim 1. In addition, D1 discloses a transmitter (21) for generating a defined constant magnetic field within the navigation environment, a pointer navigation instrument (25) with an integral magnetic field detector (23, 51), in which the magnetic field detector (23, 51) and the continuous field transmitter (23) represent the tracking device (see page 14, paragraph 4 - page 15, first paragraph), and the magnetic field detector records the position of the instrument by directionally measuring the field intensity (although not explicitly disclosed, this feature nevertheless seems to be implicitly apparent from D1).

The difference between the subject matter of Claim 1 and that disclosed in D1 appears to be the menu-driven means of controlling the system, as defined in the amended Claim 1. This feature is not disclosed in the publications cited, nor is it obvious from them. Thus Claim 1 and its dependent Claims 2-7 appear to meet the requirements of PCT Article 33(2) to (4).

**INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

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**VII. Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

- 3.1 Pursuant to PCT Rule 5.1(a)(ii), the description should have cited D1 and outlined the prior art disclosed therein. Moreover, the independent claims should have been drafted in the correct two-part form (PCT Rule 6.3(b)).
- 3.2 The features mentioned in the claims should have been followed by reference signs placed between parentheses (PCT Rule 6.2(b)).